REMARKS/ARGUMENT

Claims 1-16 are pending in the application with all claims having been amended.

Claims 2-12 and 14-16 have been objected to because "characterised" should be spelled "characterized". Neither "characterised" nor "characterized" appears in the amended claims.

Claims 2-12 and 14-16 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as their invention. Specifically, according to the Examiner:

> "The term 'characterized in that' is a vague and indefinite term. The language is describing the structure as having the quality of or characteristic of a particular structure. The statement implies that the structure is similar to but not necessarily as disclosed."

The term "characterized in that" no longer appears in the claims.

Accordingly, it is requested that the rejection of claims 2-12 and 14-16 under 35 U.S.C. 112, second paragraph, be withdrawn.

Claims 1-9 and 12-16 have been rejected under 35 U.S.C. 112, first paragraph, because, according to the Examiner, the specification, while being enabling forcarbendazim, a benzimidazole derivative, does not reasonably provide enablement for all compounds capable of inhibiting mitosis or cell division.

Claim 1 has been amended to recite that the compounds capable of inhibiting mitosis or cell division are selected from the group consisting of:

[5-Chloro-6-(2,4,6-trifluoro-phenyl)-[1,2,4]triazolo[1,5-α]pyrimidi n-7-yl]-

((R)-1,2,2-trimethyl-propyl)-amine,

[5-Chloro-6-(2,4,6-trifluoro-phenyl)-[1,2,4]triazolo[1,5-α]pyrimidin-7-yl]-

((R)-1,2-dimethyl-propyl)-amine,

5-Chloro-7-(4-methyl-piperidin-1-yl)-6-(2,4,6-trifluoro-phenyl)-[1,2,4]triazolo[1,5-α]

pyrimidine, benzimidazole derivatives, thiophanate, thiophanate-methyl, diethofencarb, zoxamide, and pencycuron. This amendment is supported in the specification in the paragraph beginning on page 3, at line 25. It is submitted that this listing is far fewer than "all compounds capable of inhibiting mitosis or cell division" and would be well within the abilities of those of ordinary skill in the art to comprehend and screen without undue experimentation.

All of the claims remaining in the application, except for claim 16, are directed to *compositions*. The specification discloses *utility* for these compounds as fungicides, but claims 1-15 are not directed to the *use* of the compounds as fungicides. When a composition of matter is the subject of an invention, it is only required that a utility for the composition be disclosed, which has been done here. It is submitted that more than this is not required where the novel and unobvious compositions are being claimed, rather than the use of such compositions as fungicides. It is possible that compositions within the scope of the present invention may have entirely different uses that have not as yet been discovered. This, however, should not put limitations on the scope of the compositions being claimed.

> "The determination of the propriety of a rejection based upon the scope of a claim relative to the scope of the enablement involves two stages of inquiry. The first is to determine how broad the claim is with respect to the disclosure. The entire

claim must be considered. The second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation. ...

In In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976), the court stated:

[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts." MPEP 2164.08.

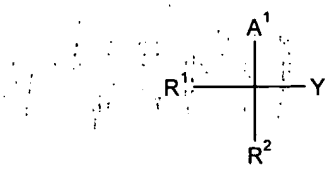
Here, the determination of whether the experimentation required to make and use the claimed invention is undue should be directed to what experimentation, if any, is needed to *prepare the compositions claimed*, and *not* to how all such compositions might be employed as fungicides.

Accordingly, it is requested that the rejection of claims 1-9 and 12-16 under 35 U.S.C. 112, first paragraph, be withdrawn.

Claim 16 has been rejected under 35 U.S.C. 102(e) as being anticipated by Cooke et al. (U.S. Patent No. 6,821,992).

Claims 1-15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Cooke et al. in view of Brandes et al. (U.S. Patent No. 5,532,262), and Hammond et al. (Exploring the mechanisms of action of FB642 at the cellular level, 2001).

Cooke et al. disclose compounds of general formula I,



where A^1, R^1, R^2 and Y are as defined in the description; and to their use as phytopathogenic fungicides.

It has been pointed out in the second paragraph of the present specification that international patent application WO 01/11965 (an equivalent of U.S. Patent No. 6,821,992) generically discloses numerous pyridylethylbenzamide derivatives and that the possibility of combining one or more of these numerous pyridylethylbenzamide derivatives with known fungicidal products to develop a fungicidal activity is disclosed in general terms, without any specific example or biological data.

It is submitted, however, that a pyridylethylbenzamide derivative having the general formula (I) of the present application is neither disclosed not suggested by Cooke et al.

The structure of general formula (I) of the present invention includes a four atom linking group (to use the terminology of Cooke et al.) between the pyridine ring and the phenyl ring, with the pyridine ring being directly attached to a carbon atom, i.e. a CH_2 group.

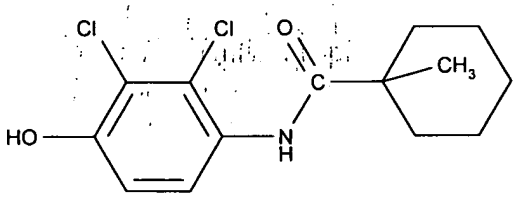
Cooke et al. teach that Y is either an -L-A^2- moiety or an -L^1-A^3- moiety, where L is a three atom linker and L^1 is a four atom linker. Thus, since the compound employed in the practice of the present invention comprises a four atom linker, only the -L^1-A^3- moiety of Cooke

et al. needs to be considered. An examination of the definition of L^1 in column 1 of Cooke et al. beginning at line 45, however, reveals that in all cases, the atom directly attached to the pyridine group is nitrogen, not carbon, i.e., $-N(R^9)C(=X)-X^1-CH(R^7)-$, $-N(R^9)C(=X)CH(R^7)CH(R^8)-$, $-N(R^9)C(=X)C(R^7)=C(R^8)-$, $-N(R^9)C(R^7)=C(R^8)-C(=X)-$, $-N(R^9)C(R^7)=C(R^8)-SO_2-$, $-N(R^9)C(=X)C(R^7)(R^8)-SO_2-$ and $-N(R^9)C(=X)C(R^7)(R^8)-X^1-$; wherein A^1, the pyridine ring, is *attached to the left hand side of linker* L^1. Thus, it is clear that the compounds disclosed by Cooke et al. do not read on the pyridylethylbenzamide derivatives employed in the practice of the present invention.

Further, there is no teaching or suggestion in Cooke et al. of the synergistic effect obtained when these pyridylethylbenzamide derivatives are combined with compounds capable of inhibiting mitosis and cell division, such as carbendazim.

The secondary references, Brandes et al. and Hammond et al., fail to supplement these deficiencies, as a reference, of Cooke et al.

Brandes et al. merely disclose that a compound of the formula:



which is nothing at all like the pyridylethylbenzamide derivatives employed in the practice of the present invention, can be combined with known fungicidal active compounds, such as carbendazim and/or diethofencarb and/or iprodione and/or benomyl, among others.

Hammond et al. do nothing more than teach that carbendazim is a known fungicide. There is no mention of its use in combination with anything resembling the pyridylethylbenzamide derivatives employed in the practice of the present invention.

Accordingly, it is requested that the rejections of claim 16 under 35 U.S.C. 102(e) as being anticipated by Cooke et al. and claims 1-15 under 35 U.S.C. 103(a) as being unpatentable over Cooke et al. in view of Brandes et al. and Hammond et al. be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance and an early Office Action to that end is earnestly requested.

Respectfully submitted,

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